

REMARKS

The Office Action dated November 3, 2004 has been reviewed and carefully considered. Claims 1-17 remain pending in this case, claims 1, 3, 7, 12 and 15 being the independent claims. The Examiner's allowance of claims 7-17 is appreciated. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claim 1 stands rejected under 35 U.S.C. 102(e) as unpatentable over U.S. Patent No. 6,148,197 to Bridges et al. ("Bridges").

Claim 1 recites:

responsive to the determination of deviation, informing, by the portable radio telephone, to a mobile switching center of said determination of deviation.

Bridges fails to disclose or suggest this feature of the present claim 1.

FIG. 3 in Bridges shows a determination of deviation (S.6: NO branch), but that determination results merely in an internal search by the mobile phone (S.10) and in the making of a subsequent internally-made decision (S.12) as to whether the current carrier is preferred. Depending on the outcome of the decision, the mobile terminal either remains with its current carrier or obtains service from a band it identifies from another internal search. No informing occurs to a message switching center (MSC)

of the determination of deviation responsive to that determination.

Perhaps, the Office Action envisions that an additional box be placed in Bridges FIG. 3 between S.6 and S.10 specifying that the mobile terminal informs the MSC of the determination of deviation so that the MSC can appropriately bill the subscriber. Such a suggestion would be ill-founded, for a number of reasons.

Firstly, the intelligent roaming process of Bridges FIG. 3 is performed only upon initialization of the mobile terminal (S.2). Such initialization occurs, for example, when the subscriber selects Intelligent Roaming mode (IR Mode: col. 12, lines 11-12), but it would be unreliable to expect the subscriber to make the selection if it means the subscriber would be billed at a higher rate. The only reason the subscriber is using Intelligent Roaming is to save money (col. 4, line 35: "best roaming agreement"). The whole idea of waiting for the user to make a selection so that higher billing rates can be charged to the user is probably unworkable and awkward at best. Moreover, implementing this billing control function in the mobile phone leaves open the possibility that user equipment might be fraudulently manipulated to avoid detecting deviation from the home zone, to lower billing charges.

For billing, Bridges might want to keep track of whether, when a user places a phone call, the user is within or outside the home market area. This monitoring is independent of the user-selected function of entering IR Mode (col. 12, lines 11-13:

"when an Intelligent Roaming mode (IR Mode) has been selected by the user"). Notably, the fact the IR Mode is invoked by the user implies that a user can roam without invoking the IR mode. Keeping track of whether a user placing a call is within the home market area is a function separate from what appears in Bridges FIG. 3, step S.6. Bridges might also want to keep track of when a user enters or leaves the home market area during a phone call. Again, this monitoring, as an adjunct to the billing function, is performed independently of the user invoking the IR Mode.

Secondly, Bridges discloses that a Mobile Telephone Switching Office (MTSO) may compile billing information (col. 2, lines 8-9), e.g., from statistics received from a base station such as a) call time within the home market area, and b) call time outside the home market area. These statistics do not depend upon the user invoking the IR Mode; instead, they are related to the location of the mobile station at the start of, and possibly during, a call. The compilation at the MTSO does not amount to or imply "informing, by the portable radio telephone, to a mobile switching center of said determination of deviation." There is no disclosure or suggestion that the Bridges MTSO has any knowledge of the determination made in FIG. 3, step S.6.

For at least all of the above reasons, Bridges fails to anticipate the present invention as recited in claim 1. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 2 stands rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of U.S. Patent No. 6,456,839 to Chow et al. ("Chow").

Claim 2 depends from claim 1. Although Chow relates to wireless phone service, Chow fails to make up for the deficiencies in Bridges. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 3-6 stand rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow and U.S. Patent No. 5,734,977 to Sanmugam.

Firstly, Chow is cited by the Office Action for purported disclosure of the "call origination" releasing step of present claim 3, but the cited portion of Chow merely discloses dropping an ongoing phone call.

Secondly, claim 3 recites, "checking whether a location registration request is received from a portable radio telephone; if the location registration request is received, checking whether the portable radio telephone deviates from the home zone by checking whether the current position of the portable radio telephone is included in the home-zone list; . . . and, preventing a page by the MSC to notify the portable radio telephone that the portable telephone deviated from the home zone."

The proposed combination of prior art references, even if proper motivation could be found, fails to feature the above-quoted aspect of the present claim 3.

The Office Action appears to rely on a) FIG. 3, step S.6 of Bridges, where

the mobile station determines whether it is within its home market area or deviates from the home market area; and b) the Sanmugam elimination of paging to an inactive mobile station (col. 18, line 53: "inactive").

If the purported Bridges/Chow/Sanmugam combination prevents, because the telephone is inactive, "a page . . . to notify . . . that the . . . telephone deviated," it is unclear by what means the "checking" to determine "whether the . . . telephone deviates" was performed.

In addition, it is unclear how whatever the Office Action deems to correspond to the "releasing . . . if the . . . telephone is deviated" and the "disregarding . . . if the . . . telephone deviated" relates to "call origination" or "call termination," at least Bridges fails to disclose any connection between establishment of a call and invocation of step S.6 in FIG. 3. In particular, and by way of example, after invocation of step S.6 the telephone may wander in and out of the home market area, or vice versa, without any re-execution of step S.6 to detect this.

Additionally, all this uncertainty as to where the phone is, at any given time, makes it unclear how, and under what circumstances, the Bridges/Chow/Sanmugam page presumably "to notify the . . . telephone that the . . . telephone deviated" is being prevented.

Moreover, Bridges is directed to finding the best wireless carrier when the

mobile station deviates from its home market area (Summary of the Invention, first sentence). The citation of the Office Action to cols. 17 and 18 of Bridges, in connection with both of the first two steps of claim 3, and presumably to show detection of deviation from a home market areas, relates to the downloading of a list of preferred carriers.

The proposed re-design of Bridges, to somehow incorporate the releasing and disregarding steps of the present claim 3, i.e., "releasing . . . if the . . . telephone is deviated" and the "disregarding . . . if the . . . telephone deviated," seems to oppose the idea of selecting a preferred carrier, i.e., the central operational concept of Bridges. The Office Action, in fact, relies heavily on this central operational concept throughout its citations to Bridges.

In particular, the proposed re-design changes the principle of operation of the primary reference.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01

Since the proposed modification would the principle of operation of the primary reference, the proposed combination is non-obvious.

For at least all of the above reasons, the proposed combination of references fails to render obvious the present invention as recited in claim 3.

Amendment
Serial No. 09/632,995

Docket No. 5000-1-122

Reconsideration and withdrawal of the rejection are respectfully requested.

As to the other rejected claims, each depends from base claim 3 that has been shown to be patentable, and is likewise deemed to be patentable.

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. The Examiner is invited to contact the undersigned in the event of any perceived outstanding issues so that passage of the case to issue can be effected without the need for a further Office Action.

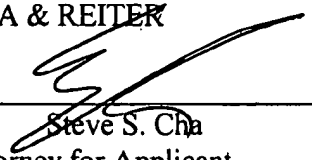
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In the event that any additional fee is required to continue the prosecution of this Application as requested, please charge such fee to Deposit Account No. 502-470.

Respectfully submitted,

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